

## **II. REMARKS**

### **RESPONSE TO RESTRICTION REQUIREMENT**

#### **Restriction Under 35 U.S.C. §121**

- **The Examiner's Position:**

The Examiner has required restriction under 35 U.S.C. § 121 to one of the following inventions:

- I. Claims 85–157, 176, 177, 245 and 246, drawn to a method for authenticating optical storage media, classified in class 369, subclass 53.21.
- II. Claims 158–175, drawn to a method of treating an optical storage medium, classified in class 369, subclass 100.
- III. Claims 178–186, drawn to an article of manufacturing, classified in class 430, subclass 270.11.
- IV. Claims 187–244 and 247–251, drawn to a data storage medium, classified in class 369, subclass 288.

The Examiner argues that groups I, II and III above are distinct and unrelated in having different modes of operation, different functions, or different effects (paragraph 2, page 2, of the Office Action).

The Examiner further argues that groups I and IV set forth above are related as combination and subcombination wherein the combination as claimed does not require the particulars of the subcombination as claimed (paragraph 3, page 2, of the Office Action). The Examiner reasons that the claimed details in the subcombination are evidence that the patentability of combination does not rely on the details of the specific subcombination (paragraph 3, pages 2 - 3, of the Office Action).

The Examiner further maintains that groups II and III - IV are unrelated in that they have different modes of operation, different functions and different effects (paragraph 4, page 3, of the Office Action).

Lastly, the Examiner asserts that groups III and IV are unrelated in that they have different modes of operation, different functions and different effects (paragraph 5, page 3, of the Office Action).

Based on such asserted "distinctiveness," and an asserted "separate status in the art as shown by their different classification," the Examiner asserts restriction is proper (paragraph 6, page 3, of the Office Action).

- **Applicants' Position:**

Applicants respectfully traverses the Examiner's restriction requirement on the basis that the search and examination of the entire application can be made without serious burden. As per M.P.E.P. §803, under such circumstances the Examiner "must examine it on the merits, even though it includes claims to independent or distinct invention." (emphasis added). In particular applicant asserts that at least groups III and IV should be searched together.

While traversing the restriction requirement, Applicant provisionally elects Group III, drawn to an article of manufacturing, should such restriction requirement be made final. If such restriction requirement is made final, Applicant will amend the claims accordingly.

Applicant acknowledges that upon cancellation of claims to a non-elected invention, and the restriction requirement being made final, that inventorship needs to be re-investigated to determine if one or more of the currently named inventors are no longer an inventor of at least one claim in the application.

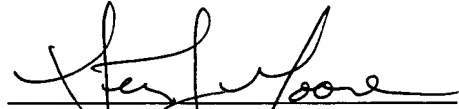
The Examiner is respectfully requested to contact the Applicant's attorney set forth below with respect to any clarification deemed necessary in respect of such elections.

**CONCLUSIONS**

An early notice of allowance in the next office is earnestly requested.

Respectfully Submitted,

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